



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,329	04/02/2001	William J. Kelly	P04490US1	1487

22885 7590 12/29/2005

MCKEE, VOORHEES & SEASE, P.L.C.  
801 GRAND AVENUE  
SUITE 3200  
DES MOINES, IA 50309-2721

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/824,329

Applicant(s)

KELLY ET AL.

Examiner

Narayanswamy Subramanian

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 12-15, 17, 18, 20-22 and 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16, 19, 23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to applicants' communication filed on April 2, 2001. Claims 1-30 pending in the application are subject to restriction/election as discussed below. After a phone call on November 17, 2005, a provisional election was made by Mr. John Goodhue (Attorney for the Applicants) to prosecute claims 1-11, 16, 19 and 23-26. Accordingly claims 12-15, 17, 18, 20-22 and 27-30 are withdrawn from consideration as being directed to non-elected inventions/species. Applicant is respectfully requested to cancel the withdrawn non-elected claims 27-30 of Invention II in response to this office action. Claims 1-11, 16, 19 and 23-26 have been examined. The restriction/election and rejections are stated below.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-26, drawn to methods of providing group retirement plan administration to one or more sponsors, at least one sponsor having one or more participants enrolled in a retirement plan, the method comprising: electronically receiving contribution information from a sponsor; automatically updating a provider database based on the contribution information received from a sponsor; electronically providing account information to at least one sponsor; and electronically providing account information to at least one participant, classified in class 705, subclass 36R.

II. Claims 27-30, drawn to group retirement plan administration systems for permitting a provider to administer at least one group retirement plan for at least one sponsor, and at least one participant associated with at least one of the group retirement plans, the system comprising: a provider group retirement plan database for storing information associated with at

Art Unit: 3624

least one group retirement plan; and a provider web server capable of exchanging information with the provider group retirement plan database, the web server providing secured access to at least one sponsor, and the web sever providing secured access to at least one participant associated with a group retirement plan, classified in class 705, subclass 36R.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to methods of providing group retirement plan administration to one or more sponsors, at least one sponsor having one or more participants enrolled in a retirement plan, whereas invention II relates to systems for permitting a provider to administer at least one group retirement plan for at least one sponsor, and at least one participant associated with at least one of the group retirement plans. See MPEP § 806.05(d).

The methods of invention I can be implemented using a configuration of system different from what is claimed in invention II. Hence invention I has a utility separate from that of invention II. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Invention I further contains claims directed to the following patentably distinct species of the methods of providing group retirement plan administration to one or more sponsors:

The following claims are directed to different species of the generic feature of electronically providing account information to sponsors as discussed below.

Specie 1A      Claim 12

Specie 1B      Claim 13

Specie 1C      Claim 14

Specie 1D      Claim 15

Specie 1E      Claim 16

4.      Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Invention I further contains claims directed to the following patentably distinct species of the methods of providing group retirement plan administration to one or more sponsors:

The following claims are directed to different species of the generic feature of electronically providing account information to participants as discussed below.

Specie 2A      Claim 17

Specie 2B      Claim 18

Specie 2C      Claim 19

Specie 2D      Claim 20

Specie 2E      Claim 21

Specie 2F      Claim 22

5.      Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

6.      After a telephone conversation with Mr. John Goodhue (Attorney for the Applicants) on November 17, 2005, a provisional election was made to prosecute claims of invention I. Further species corresponding to claims 16 and 19 were also elected. Accordingly claims 12-15, 17, 18,

Art Unit: 3624

20-22 and 27-30 are withdrawn from consideration as being directed to non-elected inventions/species. Applicant is respectfully requested to cancel the withdrawn non-elected claims 27-30 of invention II in response to this office action.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5-8 recite the limitation " the step of electronically providing account summary information" in the first line of these claims. There is insufficient antecedent basis for this limitation in these claims.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 3-8, 16 and 19 rejected under 35 U.S.C. 102(e) as being anticipated by Gilbert et al (US Patent 6,041,313).

Claim 1, Gilbert teaches a method of providing group retirement plan administration to one or more sponsors, at least one sponsor having one or more participants enrolled in a retirement plan, the method comprising: electronically receiving contribution information from a sponsor (See Gilbert Figure 1, Column 8 lines 6-15); automatically updating a provider database

Art Unit: 3624

based on the contribution information received from a sponsor (See Gilbert Figure 1, Column 8 lines 39-55); electronically providing account information to at least one sponsor (See Gilbert Figure 1, Column 9 lines 1-18); and electronically providing account information to at least one participant (See Gilbert Figure 1, Column 8 lines 64-67 and Column 11 lines 36-43).

Claims 3-8, Gilbert teaches the steps of electronically receiving contribution information from the sponsor over a computer network including the Internet (See Gilbert Figure 1, Column 8 lines 6-15 and Column 19 lines 43-50); electronically providing account summary information to at least one sponsor over a computer network including the Internet (See Gilbert Figure 1, Column 8 lines 64-67, Column 11 lines 31-36 and Column 19 lines 43-50); and electronically providing account summary information to participants over a computer network including the Internet (See Gilbert Figure 1, Column 11 lines 37-43 and Column 19 lines 43-50).

Claims 16 and 19, Gilbert teaches the steps of electronically providing a summary of the participation of employees of the sponsor within a group retirement plan to the sponsor (See Gilbert Column 7 lines 15-21 and Column 11 lines 31-36); and electronically providing investment direction information to participants (See Gilbert Column 11 lines 37-43).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 9-11 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert et al (US Patent 6,041,313).

Claim 23, Gilbert teaches a method of providing group retirement plan administration to one or more sponsors, at least one sponsor having one or more participants enrolled in a retirement plan, the method comprising: electronically receiving contribution information from a sponsor (See Gilbert Figure 1, Column 8 lines 6-15); automatically updating a provider database based on the contribution information received from the sponsor (See Gilbert Figure 1, Column 8 lines 39-55); transferring funds between at least one account associated with a sponsor and at least one account associated with a provider (See Gilbert Column 16 lines 24-30); receiving investment allocation information from a participant (See Gilbert Column 7 lines 26-31); and automatically updating a provider database based on the investment allocation information received from the participant (See Gilbert Figure 1, Column 9 line 57 – Column 10 line 33, Column 11 lines 5-11 and Column 11 lines 37-43).

Gilbert does not explicitly teach the steps of electronically transferring funds between at least one account associated with a sponsor and at least one account associated with a provider; and electronically receiving investment allocation information from a participant.

Official notice is taken that the steps of electronically transferring funds between accounts and electronically receiving information from a user is old and well known in the art. Electronic transfers save time compared to manual transfers and electronically receiving and sending information makes the information transfer timely and more efficient.



It would have been obvious to one of ordinary skill in the art at the time of invention to modify Gilbert to include these steps. Inclusion of these steps would have saved time and made the process more efficient.

Claims 24 and 25, Gilbert teaches the steps of electronically receiving contribution information from the sponsor over a computer network including the Internet (See Gilbert Figure 1, Column 8 lines 6-15 and Column 19 lines 43-50).

Claims 2, 9 and 10, Gilbert teaches a method of claim 1 as discussed above including the steps of transferring funds between at least one account associated with a sponsor and at least one account associated with a provider (See Gilbert Column 16 lines 24-30); receiving investment allocation information from a participant (See Gilbert Column 7 lines 26-31); and automatically updating a provider database based on the investment allocation information received from the participant (See Gilbert Figure 1, Column 9 line 57 – Column 10 line 33, Column 11 lines 5-11 and Column 11 lines 37-43).

Gilbert does not explicitly teach the steps of electronically transferring funds between at least one account associated with a sponsor and at least one account associated with a provider; and electronically receiving investment allocation information from a participant.

Official notice is taken that the steps of electronically transferring funds between accounts and electronically receiving information from a user is old and well known in the art. Electronic transfers save time compared to manual transfers and electronically receiving and sending information makes the information transfer timely and more efficient.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Gilbert to include these steps. Inclusion of these steps would have saved time and made the process more efficient.

Claims 11 and 26, Gilbert teaches methods of claims 1 and 23 as discussed above.

Gilbert does not explicitly teach the step of performing an electronic financial securities transaction based on the investment allocation information received from the participant.

Official notice is taken that the step of performing an electronic financial securities transaction based on the investment allocation information received from an investor is old and well known in the art. Performing electronic financial securities transaction based on the investment allocation information received ensures quick purchase or sale of securities at or close to prevailing market prices for those securities.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Gilbert to include this step. Inclusion of this step would have enabled the investor to close the transaction at or close to prevailing market prices.

### **Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Edelman (US Patent 6,064,986) (May 16, 2000) Computer Assisted And/Or Implemented Process and Architecture for Customer Account Creation Maintenance and Administration for an Investment and/or Retirement Program

(b) Starr (US Patent 6,606,606 B2) (August 12, 2003) Systems and Methods for Performing Integrated Financial Transaction


(c) Valentino (US Patent 4,648,037) (March 3, 1997) Method and Apparatus for Benefit and Financial Communication

(d) Jones et al (US Patent 6,021,397) (February 1, 2000) Financial Advisory System

(e) Schoen et al (US Patent 6,235,176 B1) (May 22, 2001) Computer Apparatus and Method for Defined Contribution and Profit Sharing Pension and Disability Plan

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Dr. N. Subramanian  
December 21, 2005